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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,281	11/25/2003	Takayuki Hattori	2927-0163P	4758
2292 7590 01/07/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER JACKSON, MONIQUE R				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
01/07/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

### Office Action Summary

**Application No.**

10/720,281

**Applicant(s)**

HATTORI ET AL.

**Examiner**

Monique R. Jackson

**Art Unit**

1794

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5 and 7-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5 and 7-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5508)
- Paper No(s)/Mail Date 5/12/08
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The amendment filed 10/6/08 has been entered. Claim 6 has been canceled. Claims 1-3, 5, and 7-32 are pending in the application. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### *Claim Rejections - 35 USC § 102*

2. Claims 28-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Hattori et al for the reasons recited in the prior office action and restated below.

Hattori et al teaches a conductive elastomer composition having rubber-like elasticity and flexibility and thermoplastic-resin-like moldability and realizing a high conductivity, specifically a volume resistivity in the range from  $10^4$  to  $10^{11}$   $\Omega$ -cm, when measured as claimed, wherein the conductive elastomer composition is suitable for producing conductive belts and rollers for an image-forming apparatus, wherein the composition taught by Hattori et al comprises the same polymers and conductive salt in amounts that read upon the claimed invention (Abstract; Col. 2-Col. 8, Col. 11-12; Examples.) Specifically, Hattori et al teach that the conductive elastomer composition includes a thermoplastic elastomer composition (A) containing a compound (A1) composed of a thermoplastic resin and/or a thermoplastic elastomer, such as polyester elastomers as claimed (*continuous matrix phase*) and a compound (A2), composed of a crosslinkable rubber and/or a crosslinkable thermoplastic elastomer such as EPDM as claimed (*second discontinuous phase*), dispersed in the compound (A1) by dynamically crosslinking the compound (A2); and an ionic-conductive agent (B), containing a metal salt and a polyether-containing block copolymer resin as claimed, dispersed in the thermoplastic elastomer composition (A) (*first discontinuous phase*), wherein the salt is associated with the polyether-containing block copolymer and the

conductive agent (B) is preferentially dispersed in the matrix A1 not A2; and also teach the use of acrylonitrile-butadiene rubber contained in the composition. Hattori et al also teach that a conductive member formed from the composition has a compression set less than 30% when measured as claimed and a Shore hardness of 10 to 50 (Col. 12, lines 45-52.) Hattori et al also teach that the composition is formed by kneading the components as claimed. With respect to the other physical properties and relationships claimed, the Examiner takes the position that the invention taught by Hattori et al, comprising the same materials in the same amounts, would inherently possess the same properties as claimed.

### ***Double Patenting***

3. Claims 1-3, 5, and 7-33 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 7,141,183 for the reasons recited in the prior office action wherein it is noted that the patent claims are directed to the conductive elastomer composition as well as a conductive roller formed from the composition and a method of producing the composition by mixing the materials, and hence molding or extruding the composition to form the roller or conductive member would have been an obvious step to one having ordinary skill in the art at the time of the invention. In addition, as previously recited, it would have been obvious to one having ordinary skill in the art to combine dependent claim limitations and to recognize that the A2 and B components form discontinuous phases in the A1 matrix. It would also have been obvious to one skilled in the art to recognize that the conductive composition of the patent would provide the same properties as instantly claimed and to utilize routine experimentation to determine the optimum amount of each component and suitable conductive salt to provide the desired conductivity for a particular end

use. Further, one having ordinary skill in the art would have been motivated to include a flame retardant additive wherein the claimed additive is an obvious species of flame retardant utilized in the art.

***Response to Arguments***

4. Applicant's arguments filed 10/6/08 have been considered but are not persuasive with regards to the 102(e) rejection of Claims 28-32 over Hattori et al or the obviousness double patenting rejection of all claims over Hattori et al. With respect to Claims 28-32, the Examiner notes that the limitations of Claim 6 have not been incorporated into Claims 28-32. With regards to the double patenting rejection, the Applicant argues that the instant claims are directed to a conductive member while the patent claims are directed to a conductive composition. However, as recited above, the patent claims are also directed to a member or roller formed from the conductive composition and hence reads upon the claimed conductive member. Further, the patent claims encompass a method of producing the conductive composition by mixing or kneading the same materials as claimed. In terms of the other limitations, the Applicant merely recites that they would not have been obvious however the Examiner maintains her position that the instantly claimed invention is an obvious variation of the claims of USPN 7,141,183 and hence maintains the double patenting rejection.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R. Jackson whose telephone number is 571-272-1508. The examiner can normally be reached on Mondays-Thursdays, 10:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.